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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/904,201	07/11/2001	Eugene de Juan JR.	56247 (71699)	1217

7590 10/07/2002

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EXAMINER

DEMILLE, DANTON D

ART UNIT

PAPER NUMBER

3764

DATE MAILED: 10/07/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/904,201	JUAN ET AL.
	Examiner	Art Unit
	Danton DeMille	3764

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on \_\_\_\_.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-20 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_ is/are allowed.

6) Claim(s) 1-20 is/are rejected.

7) Claim(s) \_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.

4) Interview Summary (PTO-413) Paper No(s) \_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Some of the language in the claims is not understood. In claim 1, line 1, it is not clear what is meant by the IOL system "comprising and insertion and injection device and a deflated lens member". Comprising what and insertion and injection device and a deflated lens member? In line 6 it is not clear what is meant by the deflated lens member is mounted "about and to an end of the moveable member". About what and to an end of the moveable member?

✓ In claim 2, line 2, "moveable disposed" would appear to be --moveably disposed--.

✓ In claim 7, line 2, it is not clear what is meant by the self-sealing mechanism "in which is removably and sealingly received the moveable member".

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --  
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 9 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Galib. Galib teaches an insertion and injection device for inserting a deflated lens member comprising a moveable member 65 having an outlet port at the distal end thereof. The deflated lens member is mounted about the end of the moveable member and sealingly engaged with another portion of

the moveable member. The moveable member outlet communicates with the deflated member compartment.

*Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

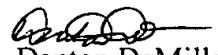
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7, 10-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Galib in view of Sahatjian. Galib may not teach an outer member for supporting the moveable member however, using a catheter for housing the moveable member to aid in passing the system within the opening in the eye to the deploying site is conventional in the art of inserting inflatable devices within openings in the body. Such would have been an obvious provision and is exemplified by Sahatjian. It would have been obvious to one of ordinary skill in the art to modify Galib to use a catheter for housing and supporting the moveable member and deflated member such as taught by Sahatjian in order to aid in passing the inflatable member through the opening in the eye. Regarding claims 5, 6, the number of outlets is well within the realm of the artisan of ordinary skill and an obvious provision as desired or required.

Claims 1 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peyman in view of Galib and Sahatjian. Peyman appears silent with regard to exactly how the IOL is inserted through the eye however, Peyman does teach that in the deflated condition it is sufficiently small to enable the IOL to be inserted into the eye through a relatively small incision. The manner and means of inserting it is not detailed. Galib teaches the process of inserting the

IOL using a moveable member and Sahatjian teaches the conventional outer member as noted above. It would have been obvious to one of ordinary skill in the art to modify Peyman to insert the Peyman device using the inner and outer members as taught by Galib and Sahatjian as noted above to aid in implanting the IOL through the relatively small incision.

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